

REMARKS

Claims 1-64 are currently pending in this application, with claim 1 being in independent format. Claims 2-4, 6-13, 18, and 42-64 have been withdrawn. Claims 1, 5, 14-17, and 19-41 stand rejected.

In the Office Action mailed September 30, 2008, the Examiner rejects independent claim 1 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,668,273 to Allen et al. (hereinafter, the Allen patent). For at least the reasons discussed below, Applicants submit that independent claim 1 is not obvious over the prior art, including the Allen patent.

In the Office Action, the Examiner admits that "[t]he Allen reference fails to anticipate the claimed inherent viscosity range of 0.05 to 0.13 dL/g" (Office Action, p. 2, II. 19-20). In an attempt to cure this deficiency, the Examiner states that "the Allen reference discloses a lower limit of 0.20 dL/g, wherein it is the examiner's position that one skilled in the art would have expected the composition of the Allen reference to have the same properties as the claimed composition. Additionally, a difference of 0.07 dL/g in the inherent viscosity is not expected to change the properties of the composition" (Office Action, p. 3, II. 1-5).

In response to the Examiner's assertion, Applicants have submitted a declaration under 37 C.F.R. § 1.132 from John M. Allen (hereinafter, the Allen declaration). Mr. Allen is an expert in the field of cellulose esters and is the first named inventor on the Allen patent. According to the Allen declaration, lowering the IV of the carboxyalkyl cellulose ester described in the Allen patent would render the invention of the Allen patent unfit for its intended purpose. Specifically, one of the intended purposes of the invention described in the Allen patent is to employ carboxyalkyl cellulose esters in waterborne coatings. According to the Allen patent, the carboxyalkyl cellulose esters disclosed therein "exhibit unusual rheological properties illustrated by an exponential increase in viscosity with a small increase in concentration of CMC ester" (Allen patent, col. 2, II. 55-57). However, according to the Allen declaration, if a carboxyalkyl cellulose ester having an IV below about 0.2 dL/g was employed, this benefit would not be achieved and the carboxyalkyl cellulose ester would be rendered unsuited for its

intended purpose. Therefore, Applicants submit that a carboxyalkyl cellulose ester having an IV of about 0.2 dL/g does, in fact, possess significantly different properties than one having an IV of between 0.05 and 0.13 dL/g, as is recited in independent claim 1. Thus, one of skill in the art would not expect otherwise, as the Examiner contends.

In addition, Applicants submit that, in view of the Allen declaration, the Examiner's reliance on the Allen patent is insufficient to establish a *prima facie* case of obviousness for independent claim 1. According to the MPEP, "the proposed modification cannot render the prior art unsatisfactory for its intended purpose" (MPEP § 2143.01(V)). As discussed above and in the Allen declaration, modifying the carboxyalkyl cellulose ester described in the Allen patent would render it unfit for use in waterborne coatings. Accordingly, the disclosure of the Allen patent in combination with the Examiner's proposed modification fails to establish a *prima facie* case of obviousness. Therefore, Applicants respectfully request the rejection of independent claim 1 as being obvious over the Allen patent be withdrawn.

In the Office Action, the Examiner further rejects independent claim 1 under 35 U.S.C. § 103(a) as being obvious over PCT Published Application No. WO 01/35719 to Obie (hereinafter, Obie). For at least the reasons given below, Applicants submit that independent claim 1 is not obvious over the prior art, including Obie.

As with the Allen patent discussed above, the Examiner admits that "[t]he Obie reference fails to anticipate the claimed inherent viscosity range of 0.05 to 0.13 dL/g" (Office Action, p. 4, ll. 9-10). Attempting to cure this deficiency, the Examiner states that "it is noted that the Obie reference discloses a lower limit of 0.2 dL/g, wherein it is the examiner's position that one skilled in the art would have expected the composition of the Obie reference to have the same properties as the claimed composition. Additionally, a difference of 0.07 dL/g in the inherent viscosity is not expected to change the properties of the composition" (Office Action, p. 4, ll. 12-16).

As mentioned above, Applicants have submitted a declaration under 37 C.F.R. § 1.132 from John M. Allen, whose formal education and industrial experience clearly establish him as an expert in the field of cellulose ester chemistry. In regards to Obie, the Allen declaration establishes that one of skill in the art would not have found it

obvious to lower the IV of the carboxyalkyl cellulose esters below 0.2 dL/g. This is because, as with the Allen patent, doing so would render Obie unfit for its intended purpose. According to the Allen declaration, "the intended purpose of Obie is to employ carboxyalkyl cellulose esters in waterborne coatings, specifically aqueous stain compositions. . . . [W]aterborne coatings require a certain viscosity level in order to function properly as coating compositions. However, if a carboxyalkyl cellulose ester having an IV below 0.2 dL/g was employed in the invention of Obie the resulting waterborne coatings would not achieve the required viscosity level" (Allen declaration, p. 2, ll. 28-30 to p. 3, ll. 1-3 (citations omitted)). Therefore, Applicants submit that a carboxyalkyl cellulose ester having an IV of about 0.2 dL/g does, in fact, possess significantly different properties than one having an IV of between 0.05 and 0.13 dL/g, as is recited in independent claim 1. Thus, one of skill in the art would not expect otherwise, as the Examiner contends.

In addition, Applicants submit that, in view of the Allen declaration, the Examiner's reliance on Obie is insufficient to establish a *prima facie* case of obviousness for independent claim 1. According to the MPEP, "the proposed modification cannot render the prior art unsatisfactory for its intended purpose" (MPEP § 2143.01(V)). As discussed above and in the Allen declaration, modifying the carboxyalkyl cellulose ester in Obie would render it unfit for use in waterborne coatings. Accordingly, Obie in combination with the Examiner's proposed modification fails to establish a *prima facie* case of obviousness. Therefore, Applicants respectfully request the rejection of independent claim 1 as being obvious over Obie be withdrawn.

According to the foregoing, Applicants submit that independent claim 1 is in condition for allowance. Additionally, while claims 5, 14-17, and 19-41, which depend from independent claim 1, each recites additional patentable features, these claims should also be in condition for allowance because they depend from a patentable independent claim (MPEP § 2143.03).

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In light of the foregoing, Applicants submit that claims 1, 5, 14-17, and 19-41 are in condition for allowance. Further, since claim 1 is generic to all pending claims, Applicants request rejoinder of all withdrawn claims and allowance of claims 1-64.

Respectfully submitted,

/Tammye L. Taylor/

Eastman Chemical Company
P.O. Box 511
Kingsport, Tennessee 37662
Phone: (423) 229-8862
FAX: (423) 229-1239

Tammye L. Taylor
Registration No. 52,507

01/30/2009
Date